

REMARKS

Claims 1-9 remain pending after this response.

Withdrawn Rejection

Applicants acknowledge with appreciation the withdrawal of the prior rejections under 35 USC 103(a).

Pending Claims

Applicants note that the Examiner makes reference only to claims 1-8 in the outstanding Action. The Examiner appears to have inadvertently omitted reference to claim 9 (newly-added in applicants' prior response). Applicants accordingly request the Examiner to consider claim 9.

35 USC 103(a) Rejections

The Examiner issues the following prior art rejections:

- (1) Claims 1-4 and 6-8 stand rejected under 35 USC 103(a) as being unpatentable over Watanabe et al '353 in view of Yamaki et al '012.
- (2) Claim 5 stands rejected under 35 USC 103(a) as being unpatentable over Watanabe et al '353 in view of Yamaki et al '012 and Iskra '050.

Reconsideration and withdrawal of each of the above rejections is respectfully requested for the reasons set forth in detail below.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365,

1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Present Invention and Its Advantages

The present invention provides for an advantageous diaper, which possesses unexpectedly good properties relating to fitability and sustained fit, as evidenced by properties such as fit, ease of putting on a wearer and resistance to sagging as described in the instant specification. The Examiner's attention is directed to Table 1 at page 14 of the specification, reproduced below for the Examiner's convenience, which confirms that the claimed diaper exhibits highly desirable fit, ease of putting on the diaper, and resistance to sag.

TABLE 1

| | Example | | | | Comparative Ex. | |
|---|---------|-----|-----|-----|-----------------|-----|
| | 1 | 2 | 3 | 4 | 1 | 2 |
| Diaper Width W1 (mm) | 380 | 380 | 300 | 600 | 380 | 300 |
| Absorbent Core Width W2 (mm) | 140 | 180 | 100 | 250 | 140 | 200 |
| Body-surrounding Elastic Member Width W3+W4 (mm) | 240 | 240 | 200 | 400 | 50 | 200 |
| Stress σ_w of Waist Opening Portion (gf/cm) | 100 | 100 | 80 | 180 | 100 | 80 |
| Stress σ_b of Body-surrounding Portion (gf/cm) | 25 | 25 | 20 | 100 | 25 | 20 |
| Taber Stiffness of Absorbent Core (gf·cm) | 5 | 5 | 1.5 | 10 | 5 | 1.5 |
| Fit | A | A | A | B | C | B |
| Ease in Putting on Wearer | A | A | A | A | C | B |
| Resistance to Sagging | A | A | A | A | C | B |

The advantages possessed by the claimed diaper results in part from use of a plurality of body-surrounding elastic members that are disposed at side portions of the diaper, wherein the body-surrounding elastic members are not disposed in at least a center portion of a body-surrounding

portion wherein an absorbent core exists, and wherein the body-surrounding elastic members are disposed between an outer sheet which constitutes an outermost surface of the diaper and the anti-leakage sheet of the diaper.

By utilizing such a construction, fitability of the diaper is greatly improved, and at the same time bunching of the absorbent core is avoided, which produces other advantageous effects as discussed in the application.

Distinctions Over the Cited Art

Rejection of Claims 1-4 and Claims 6-8 under 35 USC 103(a)

The Examiner relies on the cited Watanabe et al and Yamaki et al references in support of the rejection of claims 1-4 and 6-8.

At page 2 of the Action the Examiner asserts that Watanabe et al “discloses all aspects of the claimed invention with the exception of the pair of cuffs and the exterior member comprising inner and outer sheets.”

Yamaki et al is said by the Examiner to cure the deficiencies of Watanabe et al, as it allegedly teaches “the use of a pair of cuffs 39 provided on lateral sides of an absorbent core, the cuffs 39 being fixed to a topsheet 36 over the length of the absorbent core”. The cuffs are further stated to “provide a pocket for containing liquid to prevent leakage from the article, as disclosed in column 3, lines 9-26.” See page 3 of the Action.

The Examiner accordingly concludes that:

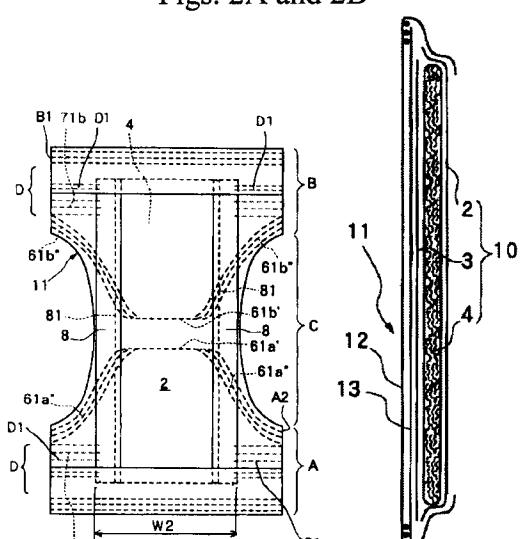
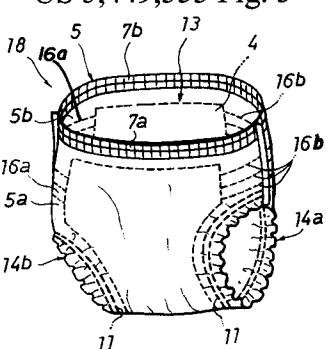
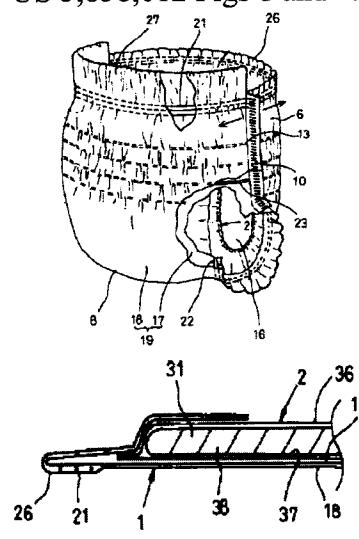
“It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the article of Watanabe with a pair of cuffs, as taught by Yamaki to prevent leakage” (page 3 of Action), and that *“It would therefore be obvious to one of ordinary skill in the art at the time of the invention to provide the article of Watanabe with an exterior member having inner and outer layers, with elastic members disposed therebetween, as taught by Yamaki, to provide extra support to the absorbent core”* (page 4 of Action).

With regard to the rejection of claim 5, the Examiner concludes at page 5 of the Action that:

"It would therefore be obvious to one of ordinary skill in the art at the time of the invention to construct the absorbent core of Watanabe with a Taber stiffness of less than 7 g/cm, as taught by Iskra, to give the absorbent core suitable flexibility."

However, based on applicant's review of the cited prior art, it is submitted that the above rejections of the claims under 35 USC 103(a) are without basis and should be withdrawn.

In an attempt to make clear those distinctions that exist between the claimed invention and the teachings of the cited prior art, the following comparison table is presented for review by the Examiner for ease of reference:

| Present invention Figs. 2A and 2B | Watanabe US 5,449,353 Fig. 5 | Yamaki US 5,858,012 Figs 1 and 4 |
|--|---|--|
|  |  |  |
| top sheet 2 | “Y”; top sheet 2 | “Y”; topsheet 36 |
| Core 4 | “Y”; | “Y”; core 38 |
| — | “Y”; body-surrounding elastic members 16a | — |
| anti-leakage sheet 4 | “Y”; back sheet 3 | “Y”; backsheets 37 |
| Inner sheet 13 | “N” | “Y”; topsheet 17 |
| Body-surrounding elastic members 71 | “N” | “Y”; elastic members 21 |
| Elastic members are cut at their center portion | “Y”; | “N”; continuous |
| Outer sheet 12 | “N” | “Y”; backsheets 18 |

Note: “Y” = meets the limitations of the pending claims.
“N” = does not meet the limitations of the pending claims.

As can be seen from the above table, commonly-assigned Watanabe et al fails to provide for an inner sheet 13 and outer sheet 12 as are provided for in the exterior member of the instant inventive diapers. See applicants' Figures 2A and 2B, where inner sheet 13 is positioned between anti-leakage sheet 3 and outer sheet 12. Watanabe et al instead teaches the use of a liquid permeable topsheet 2, a liquid impermeable backsheet 3, and an absorbent member 4 fixedly disposed therebetween (column 4, lines 6-17).

In addition, since the elastic members 16a of Watanabe et al are disposed on the inner side of anti-leakage sheet (backsheets 3), adjacent the absorbent core 4, the position of elastic members 16a of Watanabe et al differs from those of the present invention.

The additionally-cited Yamaki et al reference does not cure the deficiencies of Watanabe et al noted above.

More specifically, the Examiner appears to not appreciate various deficiencies of Yamaki et al, such as the fact that, in the exterior member of the reference, continuous elastic members 21 are disposed between inner sheet 17 and outer sheet 18. Continuous elastic members 21 are disposed at the outer side of anti-leakage sheet (backsheets 37), which is on the opposite side of a body portion of a diaper wearer.

By contrast, since the body-surrounding elastic members 71 of the present invention are not disposed at the center portion (see Figure 2A), the body-surrounding elastic members 71 of the present invention are distinctly different from the elastic members 21 of the Yamaki et al reference.

Applicants also note that Yamaki et al fails to teach or suggest the presence of elastic members at each end of the diaper as claimed by applicants. Note Figures 2 and 5 of Yamaki et al

where it is shown that one end of the diaper includes elastic members 21, while the opposing end of the diaper includes elastic members 21 positioned inwardly from the end of the diaper.

It is accordingly not obvious to combine the exterior member and the elastic members of Yamaki et al with the diaper of Watanabe et al. As the respective embodiments of Watanabe et al and Yamaki et al are thus distinct from one another, the Examiner's attempt to combine the respective teachings of the references to result in the claimed invention is illogical.

Accordingly, no teaching or disclosure is found in the cited Watanabe et al or Yamaki et al references, taken either singly or together, that would allow one of ordinary skill in the art to arrive at the claimed invention. As such, the outstanding rejection of pending claims 1-4 and 6-8 (and presumably also claim 9) must be withdrawn.

Rejection of Claim 5 under 35 USC 103(a)

The outstanding rejection of claim 5 is similarly without basis, inasmuch as claim 5 depends from claim 1, and the additional cited reference of Iskra is simply relied upon for its teachings regarding Tabor Stiffness of an absorbent core. See page 5 of the Office Action, penultimate paragraph. That is, the cited art of Iskra is incapable of curing the deficiencies of the other applied references (*i.e.*, Watanabe et al and Yamaki et al).

Based on such distinctions it is submitted that a proper *prima facie* case of obviousness has not been established, since the cited art being applied against the pending claims does not provide for or otherwise teach of the elements of the instantly claimed invention, and provides no motivation that would allow one of ordinary skill in the art to arrive at the instant invention as claimed. Absent such teaching and motivation in the cited art, the USPTO's outstanding rejections under 35 USC 103(a) are not sustainable.

CONCLUSION

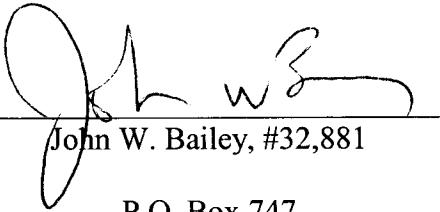
Based on the amendments and remarks presented herein, the Examiner is respectfully requested to issue a notice of Allowance clearly indicating that each of pending claims 1-9 is allowed and patentable under the provisions of Title 35 of the United States Code. In view of the above, the application is believed to be in condition for allowance, and an early indication of the same is earnestly solicited.

Should the Examiner find that any matters remain unresolved after giving proper consideration to the instant reply, the Examiner is invited to contact to contact the undersigned at the telephone number indicated, in order to help resolve such matters and expedite the instant claims to allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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